

Claims 16-18 have been rejected under 35 U.S.C. §251 as recapturing subject matter previously surrendered in the prosecution of the original application, Serial No. 08/400,260, Patent No. 5,577,767. Paragraph 5 of the Office Action states that the record constitutes an admission by the applicant that the limitation, "an inner cover, the inner cover having a first tear seam", was necessary to overcome the prior art. The Office Action references page 2, 2nd full paragraph of the May 28, 1996 Amendment; and page 5, lines 21-26 and page 6, lines 4-11 and 14-27 of the December 11, 1995 Amendment.

Hester stands for the proposition that surrender of subject matter may occur through arguments alone in the prosecution of the parent application. *Hester Indus. Inc. v. Stein Inc.*, 46 USPQ.2d 1641, 1649 (Fed. Cir. 1998). However, in the prosecution in *Hester*, it was repeatedly argued that the limitations omitted in the reissue claims were what distinguished the original claims from the prior art. *Id.* At no less than 42 places in papers submitted to the Patent Office, it was asserted that the omitted limitation distinguished the original claims from the prior art. *Id.*

Conversely, both of the above referenced argument passages in this case recite the following format: "Claim 6 recites an apparatus comprising..." the elements of claim 6; and, then, "None of the prior art discloses or suggests an apparatus as set forth in claim 6."

It is respectfully submitted that this type argument is a general statement regarding the claims as a whole and specific to no one limitation (i.e., a "boiler plate" format) as stated

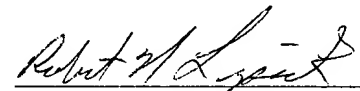
on pages 2-3 of the attached September 21, 1999 Memorandum from Stephen G. Kunin to the Patent Examining Corp. No subject matter has been surrendered by this type of argument.

Consequently, it is respectfully submitted that claims 16-18, while broader than the claims of the parent application, do not recapture subject matter surrendered in the prosecution of the original application.

Allowance and reissue of this application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this Amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



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